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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/736,529	12/13/2000	Gerald W. Mills	723.040US1	8869

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EXAMINER	
TUGBANG, ANTHONY D	

ART UNIT	PAPER NUMBER
3729	

DATE MAILED: 06/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/736,529	MILLS, GERALD W.	
	Examiner	Art Unit	
	A. Dexter Tugbang	3729	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *22 July 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-32* is/are pending in the application.

4a) Of the above claim(s) *1-8 and 11-32* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *9 and 10* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/10/04 has been entered.

Election/Restrictions

2. Claims 11-26 continue to stand as being withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 7/7/03.

3. Applicant's election with traverse of Species A, Claims 9-10, in the reply filed on 7/26/04 is acknowledged. The traversal is on the ground(s) that Claims 1-8, along with Claims 9 and 10, should be examined. Applicant(s) contend that in Species B (Claim 9), nowhere is a limitation recited of a "single revolution". And in Species A (at least Claim 1), nowhere is a limitation recited to a "mandrel". So as the examiner understands the applicant(s) reasoning, the applicant(s) believe Species A is not distinct from Species B and that all of Claims 1-10 should be examined on the merits.

This is not found persuasive and the examiner most respectfully traverses. Each of Species A through E (detailed in the Final Rejection, mailed on 3/24/04) is mutually

exclusive from one another. But the applicant(s) are traversing the election of Species made between A and B and the examiner will carefully explain the different lines of patentability between these two. Species A, now recites "rolling the mandrel with the film attached such that when rolled the end of the film is pulled....rolling" (lines 4-5 of Claim 9). While it is true that this recitation does not recite the term "single" as to the number of revolutions, this recitation does not require "more than one revolution". So the limitations of Claim 9 *can be read such that only one, single, revolution of rolling* the mandrel is required. Furthermore, Claim 9 additionally requires that "then end of the film be pulled" (line 4 of Claim 9). This is completely different from Species B, which does not require any of the features of Claim 9 above. Species B specifically recites "rolling the film...*more than one revolution*...rolling" (lines 3-4 of Claim 1 and lines 4-5 of Claim 5). Thus, Species A and Species B cannot possibly cross read on each other, which is why they each have completely different lines of patentability, would require the application of different art, and even different searches, as this would clearly place a burden on the examiner.

Therefore, the requirement is still deemed proper and is therefore made FINAL.

4. Claims 1-8 and 27-32 continue to stand as being withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected Species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 7/26/04.

Claim Objections

5. Claim 9 is objected to because of the following informalities: a comma --,-- should be inserted after "rolled" (line 4). Appropriate correction is required.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claim 9 is rejected under 35 U.S.C. 102(b) as being anticipated by Lawrence 3,243,752.

Lawrence discloses a method for forming a microcoil comprising: attaching a trace (wire 22) of conductive material to a film of flexible insulating material; attaching an end of the film to a mandrel (tube 20); and rolling the mandrel (tube 20) with the film attached such that when rolled, the end of the film is pulled, and the trace of the conductive material circumferentially wraps around a longitudinal axis of rolling (see either Figs. 2 or 3).

It is noted that the claimed "film of flexible insulating material" can be read as the insulative coating that covers the trace or wire (see col. 3, lines 67-72), or can alternatively be read as the insulative sheet 24. Figure 3 of Lawrence shows the "film of flexible insulating material" (coated wire 22 or sheet 24) being attached to the mandrel 20 and pulled in a clockwise direction.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lawrence in view of Wohlhieter 2,929,132.

Lawrence discloses the claimed manufacturing method as relied upon above in Claim 9. Lawrence does not teach affixing a solderable attaching trace to the film and soldering the trace to the mandrel.

Wohlhieter teaches that it is conventional and well known in the art of manufacturing microcoils on mandrels or cores to attach a solderable attaching trace (terminals 13 or 14) to a film (tape 18) where the trace is soldered to the mandrel (tube 15 or bobbin 11) by the connection of the solderable attaching trace to the trace of conductive material (see col. 2, lines 8-12 and col. 3, lines 30-33).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the method of Lawrence by affixing a solderable attaching trace to the film and soldering the trace to the mandrel, as taught by Wohlhieter, for at least the advantage of allowing the microcoil device to be electrically connected to other devices in operation.

Response to Arguments

10. Applicant's arguments in the response filed on 7/22/04 with respect to Claims 9 and 10 have been considered, but are moot in view of the new ground(s) of rejection.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to A. Dexter Tugbang whose telephone number is 571-272-4570. The examiner can normally be reached on Monday - Friday 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on 571-272-4690. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A. Dexter Tugbang
Primary Examiner
Art Unit 3729

May 26, 2005